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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,267	03/12/2004	Yasushi Sugaya	1344.1137	5864
21171	7590	07/20/2007	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				BOLDA, ERIC L
ART UNIT		PAPER NUMBER		
3663				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/798,267	SUGAYA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Eric Bolda	3663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 01 May 2007.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 2-44 is/are pending in the application.
- 4a) Of the above claim(s) 12, 13 and 17-42 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 2-11, 14-16, 43, 44 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment filed on May 1, 2007 has been entered.

### ***Response to Arguments***

2. Applicant's arguments filed May 1, 2007 have been fully considered
3. Applicant's argument against the 35 USC 112 (2<sup>nd</sup> para.) rejection of claims 2,3,14-16, and 43 is persuasive in view of the amendment.

Applicant's arguments with respect to rejection of claims 2-11, 14-16 and 43-44 under 35 USC 102(e) have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 2-11, 14-16 and 43-44 rejected under 35 U.S.C. 102(b) as being anticipated by Akasaka (US 6,292,288).

With regard to claim 2, 3, 14, 15, 43, and 44, Akasaka discloses in Fig. 1

- a Raman amplifier with an optical amplification medium (optical fiber) (2),
- a pumping light source (5) configured to generate a plurality of pumping lights having different wavelengths

- an optical device (coupler) (13) introducing a plurality of pumping lights to the optical fiber
- control means for controlling the pumping light source (20), Fig. 4

The clauses “capable of introducing said plurality of pumping lights...” and “said transmission station send out..” and “control means controls said pluarlity..” (claim 2) and “wherein said transmission station sends out..”, “said Raman amplifier controls aid plurality of pumping..”, (claim 16 and claims 43-44) are essentially statements of intended or desired use, and appear optional. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See In re Pearson, 181 USPQ 641; In re Yanush, 177 USPQ 705; In re Finsterwalder, 168 USPQ 530; In re Casey, 512 USPQ 235; In re Otto, 136 USPQ 458; Ex parte Masham, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

Note: in order to avoid a statement of intended use, language such as “configured to introduce..” is recommended. Because the Raman amplifier may be part of an optical communication system, a transmission station is inherently included. The plurality of monitor signals are therefore necessarily sent out at the transmission station. The monitor lights (equivalent to Applicant’s reference lights) sent to the pump

controller are different from the rest of the signal light (main signal) and have wavelengths near the Raman peak gain obtained by the plurality of pump lights, corresponding to a frequency shifted by a Raman shift frequency (15<sup>th</sup> col. lines 33-40). The optical power of the reference lights is used by the controller (15<sup>th</sup> col. lines 40-43).

With regard to claim 4, the transmission station sends information on at least some of the monitor (reference) lights.

With regard to claims 5-6, the WDM signal light is arranged on frequency grids.

With regard to claims 7, the reference lights in the WDM light are detected a the photodiodes (19), and the optical powers of the monitor lights detected are equalized (gain flattened) (15<sup>th</sup> col. lines 43-50).

With regard to claim 10-11, the control means utilizes the average value of the optical powers of the monitor light (1<sup>st</sup> col. line39-41).

#### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akasaka as applied to claim 7 above, and further in view of Sobe (US Pat. App. Pub. 2003/0117694). With regard to claims 8 and 9, Akasaka discloses all the elements of the claim except, that the detecting means is an optical spectrum analyzer, and the the

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detecting means comprises reflecting means. However, Sobe discloses in Fig. 9 an optical amplifier supplying a pumping light (30) via a coupler (62-1) to an optical amplification medium (10). The optical amplification medium is part of an optical transmission system. A monitoring light which is together with the WDM light (see para. [0241]) is transmitted along the optical amplification medium. The pump light has a plurality of different wavelengths (para. [0170]). The transmission station sends out a plurality of reference lights. The plurality of pumping lights are controlled via (65) based on the optical powers of the plurality of reference lights. the reference lights in the WDM light are detected by an optical spectrum analyzer (50-2). The reference light is selectively reflected at (61-2). It would have been obvious to one skilled in the art (e. g. an optical engineer) to use the optical spectrum analyzer and reflection as an alternative to the detection configuration of Akasaka, to decrease the number of optical filters used in the controller.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Eric Bolda whose telephone number is 571-272-8104. The examiner can normally be reached on M-F from 8:30am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Jack Keith, can be reached on 571-272-6878. Please note the fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Eric Bolda

JACK KEITH  
SUPERVISORY PATENT EXAMINER